

## REMARKS

Claims 1, 3 to 5, 8 to 9 and 20 to 31 are pending. Support for new claims 20 to 27 is found in the specification page 5, lines 5 to 14 and page 8, line 4, for claim 28 at page 5, lines 1 to 2, for claims 29 to 30 at page 4, lines 5 to 18 and for claim 31 at page 10, line 3.

The withdrawal of the 35 U.S.C. §103(a) rejection of claims 1, 2 and 8 to 9 over Bhatti is noted and appreciated.

Claims 1, 3 and 19 were rejected under 35 U.S.C. §102(b) over Blankenship et al.; claims 1 and 4 to 7 were rejected under 35 U.S.C. §103(a) over Dietzsch et al.; and claims 1 and 8 to 9 were rejected under 35 U.S.C. §103(a) over “Applicant’s prior art teaching” and Palmquist.

Claim 1 is amended to clarify that the SiO<sub>2</sub> material is fused “in a gas atmosphere of the melting zone” and the gas atmosphere comprises “at least one carrier gas and an oxidizing gas” and to correct the Markush group of claim 1. The Advisory Action states that the amended Markush group of claim 1 may be new matter. Support for rhenium, osmium, iridium and mixtures thereof is found in the original specification at page 4, line 3 and original claim 2.

Blankenship et al. and Dietzsch et al. do not teach or suggest the claim 1 method comprising “fusing... in a gas atmosphere... comprising at least one carrier gas and an oxidizing gas” Blankenship et al. and Dietzsch et al. do not teach or suggest “a refractory material wall with a protective lining selected from the group consisting of rhenium, osmium, iridium and mixtures thereof,” (claim 1). Claims 3 to 5 and 8 to 9 depend from claim 1.

Further as to claim 4, the oxidizing gas is not an “ambient” gas but rather is a gas within the furnace melting zone. The rejections of claims 1, 3 and 19 under 35 U.S.C. §102(b) over Blankenship et al. and of claims 1 and 4 to 7 under 35 U.S.C. §103(a) over Dietzsch et al. should be withdrawn.

Further, the rejection of claim 5 must be withdrawn or the PTO must point out where the claim 5 “clearly met” teachings appear in the references. “[W]hen the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference....” *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). See also MPEP §2142. The Advisory states that “... it is clear that Dietzsch continuously makes fiber.” This is improper examination. Unless the PTO can cite appropriate authority to support its position that it need not, then it must indicate where the teaching or suggestion that “Nietzsche continuously makes fiber” appears in the reference in accordance with *In re Rijckaert*, *supra* and MPEP §2142 or withdraw the rejection..

For the above reasons, the rejections of claims 1, 3 and 19 under 35 U.S.C. §102(b) over Blankenship et al. and of claims 1 and 4 to 7 under 35 U.S.C. §103(a) over Dietzsch et al. should be withdrawn.

The rejection of claims 1 and 8 to 9 under 35 U.S.C. §103(a) over “Applicant’s prior art teaching” and Palmquist is a new ground of rejection. For the following reasons, this rejection should be withdrawn.

First, the rejection is based on an improper combination of references. Palmquist discloses a method “for melting thermoplastic material.” (See, e.g., Abstract) The Advisory Action mischaracterizes this argument as “directed to different advantages.” This is incorrect. The argument is that the PTO has not met its *See In re Lee*, 277 F.3d 1338, 61 USPQ 2d 1430 (Fed. Cir. 2002) findings requirement and its *In re Lee* reasoning to combine requirement to combine references. Applicants vigorously disagree that “there is no need to establish that the rationale for modifying be identical to Applicant’s rationale” in so far as this statement is inconsistent with the *In re Lee* requirements. Applicants request the PTO to specifically state its authority for this proposition. The alleged “prior art teaching” and Palmquist provide no motivation to combine a teaching of “the drawing of molten glass to form glass articles” with a method “for melting thermoplastic material” (emphasis added) *See In re Lee, supra*. The rejection should be withdrawn.

The Final Rejection states (without relying on reference disclosure) that “[i]t would have been obvious to create the molten glass of the prior art method by using the Palmquist furnace for the advantages that Palmquist discloses.” However, the present invention does not relate to “the advantages that Palmquist discloses.” The invention relates to “a method for removing and/or reducing the effect of refractory materials contamination” (specification page 3, lines 8 to 13).

For a combination of references to render an invention obvious, there must be “some teaching, suggestion or incentive supporting the combination.” *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). The Palmquist reference contains no teaching or suggestion to employ a method “for melting thermoplastic material” for “enhanced thermal efficiency” with a teaching of “a method for removing and/or reducing the effect of refractory materials contamination” in a “method for forming an elongated fused quartz article,” (claim and dependent claims). Palmquist fails to provide an “objective teaching... [that] would lead [one skilled in the art] to combine the relevant teachings of the references.” *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

Further even improperly combined, the alleged “prior art teaching” and Palmquist do not teach or suggest claims 1 and 8 to 9. The combination does not teach or suggest “fusing [a] SiO<sub>2</sub> material in a gas atmosphere ... comprising at least one carrier gas and an oxidizing gas.” “If examination... does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent.” *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). “When the reference(s) cited by the examiner fail to establish a prima facie case of obviousness, the rejection is improper and will be overturned.” *In re Deuel*, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995).

For all of these reasons, the rejection of claims 1 and 8 to 9 under 35 U.S.C. §103(a) over “Applicant’s prior art teaching” and Palmquist should be withdrawn.

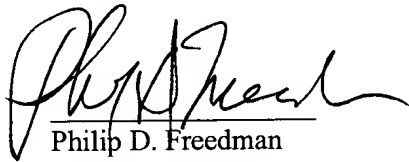
This Amendment should be entered. The Final Rejection is an improper final action. As pointed out above, the PTO has failed to point out in Dietzsche, any purported “continuous” teaching. The Final Rejection fails to address the *In re Lee* requirements

for a proper combination rejection. The Final Rejection should be withdrawn. The Amendment places the application in condition for allowance. Thus, entry of the Amendment is requested under 37 CFR §1.116.

In view of the foregoing amendments and remarks, reconsideration and allowance of claims 1, 3 to 5, 8 to 9 and 20 to 31 are respectfully requested. In the event that this Application is not allowed and this Amendment is not entered, Applicant hereby requests a personal examiner interview to advance prosecution of this case. Toward that end, Applicants representative will contact the examiner to schedule the interview shortly after filing this Amendment.

Should the Examiner believe that any further action is necessary in order to place this application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Philip D. Freedman  
Reg. No. 24,163  
Philip D. Freedman PC  
Customer Number 25101  
6000 Wescott Hills Way  
Alexandria, Virginia 22315-4747  
(703) 313-0171  
Fax: (703) 313-9322  
Email: tekesq@tekesq.com  
Telephone: (703) 313-0171

Alexandria, Virginia

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